

## **REMARKS**

Claims 1-31 were originally pending. In reply to a Restriction Requirement, applicants withdrew claims 1-8, 10, and 16-31. Therefore, claims 9 and 11-15 were pending for purposes of the present Office Action.

Because there were questions regarding the dependency of the claims, applicants have canceled claims 1-31, and presented the claims under consideration (claims 9 and 11-15) as new claims 32-37. New claims 38-46, ultimately dependent from new claim 32, have also been added. These newly added claims are based on earlier presented dependent claims, specifically: claim 38 is based on original claim 2; claim 39 on original claim 5; claim 40 on original claim 7; claims 41-44 on original claims 17-20, respectively; claim 45 on original claim 22; and claim 46 on original claim 26. Applicant respectfully submit that no new matter has been added by the introduction of these claims.

Reconsideration of these currently pending claims is respectfully requested.

### **I. Claim Objections**

Claims 12 and 14 were objected to under 37 CFR 1.75(c) as being in improper form because claims 12 and 14 were alleged to depend on a multiple dependent claim 9. Applicants respectfully maintain that the correct dependency of these claims was presented in the Preliminary Amendment filed with the application on March 24, 2005. However, in order to clarify any discrepancy, applicants have re-written pending claims 9 and 11-15 as new claims 32-37, respectively. Accordingly, the claims in question (claims 12 and 14) are now presented as claims 34 and 36 and depend from claim 32, which is in independent form. Applicants believe the claims to be in proper form and respectfully request withdrawal of the objection under 37 CFR 1.75(c) and that each of these claims be considered on the merits.

## **II. Claim Rejections under 35 USC 112**

Claims 9 and 11-15 stand rejected under 35 USC 112, second paragraph, as being indefinite for reciting the term “general” when referring to the Formula I. The term “general” has now been removed from these claims, as now presented in claims 32-37.

In addition, claim 9 (now claim 32) was rejected under 35 USC 112, first paragraph, because the claim was considered as not reasonably providing enablement for preventing disease. Although applicants maintain that the claim 32 is fully enabled, the term “prevention” has been removed from the claim in order to expedite prosecution of the application toward allowance. The phrase “reducing the risk” is also absent from the claims as currently presented.

In view of the above, applicants believe the claims meet the requirements of 35 USC 112, and respectfully request withdrawal of the objection and rejection of the claims under this provision.

## **III. Rejection of the Claims under 35 USC 102(b)**

Claims 9, 11, 13 and 15 stand rejected under 35 USC 102(b) as being anticipated by Kozak, et al. (WO 99/16741). However, it is noted that the cited Kozak reference is directed to lipophilic diesters of chelating agents for the treatment of conditions and diseases related to elevated levels of divalent metal ions, and in particular, the treatment of conditions and diseases related to elevated levels of intracellular  $\text{Ca}^{++}$  ions.

By contrast, the subject application claims the use of these lipophilic diesters of the chelating agent (DP-BAPTAs) for treating conditions and diseases associated with metalloproteinase (MMP) activity. This currently claimed method of treating MMP-related conditions or diseases is completely different, and wholly unexpected, from the elevated divalent metal ion treatment described in the Kozak reference.

The Examiner's attention is kindly drawn to the current base claim (claim 32), which expressly recites that the treatment method is to an MMP-related condition or disease. Thus, conditions or diseases not related to MMP, such as those relating to divalent metal ion elevation as described in Kozak, are not within the scope of the claims as currently presented. However, because certain of the MMP-related conditions or disorders (e.g., ischemia, Alzheimer's disease, and Parkinson's disease, and the like) may overlap with diseases or disorders described in the Kozak reference, such overlapping conditions or diseases have been removed from the current claims. Accordingly, dependent claims 35-37 and 41-44 list only MMP-related conditions or diseases which do NOT overlap with conditions or diseases that may also relate to divalent metal ion elevation.

Applicants believe that each and every element of the claims as currently presented is not disclosed in the cited reference of Kozak, and therefore maintain that an anticipation rejection cannot stand. Reconsideration and withdrawal of the rejection under 35 USC 102(b) is respectfully requested.

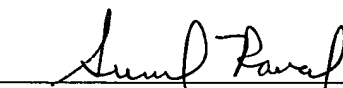
V. **CONCLUSION**

A timely and favorable action in the subject application is respectfully urged.

Respectfully submitted,

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